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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/722,102

11/25/2003

Peter M. Bonutti

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33771 7590 07/09/2007  
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EXAMINER

PHILOGENE, PEDRO

ART UNIT

PAPER NUMBER

3733

MAIL DATE

DELIVERY MODE

07/09/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/722,102

Applicant(s)

BONUTTI, PETER M.

Examiner

Pedro Philogene

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 5/4/07.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Coates (5,035,699).

With respect to claim 13, Coates discloses a total knee replacement cutting guide (10) for forming a cut on a bone in preparation to receive a total knee joint replacement component comprising a guide member (16,18) having a body configured and dimensioned for attachment to a side surface of an end portion of the bone (11) free of an extramedullary or intramedullary alignment rod; and at least one guide surface (20,21) extending from one side of the guide member to an opposite side of the guide member, the at least one guide surface configured and dimensioned for engagement with a cutting tool(30) to thereby direct the cutting tool in making only a portion of the cut surface.

With respect to claims 14-18, Coates discloses all the limitations, as best seen in FIGS.1-8, and as set forth in column 2, lines 27-67, column 3, lines 1-67.

With respect to claims 1-12, 19-37, the method steps, as set forth, would have been inherently carried out in the operation of the device, as set forth above.

With regard to the recitation that an element is "configured for", it is noted that it has been held that the recitation that an element is "configured for" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense.

Claims 1-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Haines et al. (6,056,754).

With respect to claim 13, Haines et al disclose a total knee replacement cutting guide (30) for forming a cut on a bone in preparation to receive a total knee joint replacement component comprising a guide member (32) having a body configured and dimensioned for attachment to a side surface of an end portion of the bone free of an extramedullary or intramedullary alignment rod; and at least one guide surface (36) extending from one side of the guide member to an opposite side of the guide member, the at least one guide surface configured and dimensioned for engagement with a cutting tool to thereby direct the cutting tool in making only a portion of the cut surface, as set forth in column 8, lines 54-67, column 9, lines 1-67, column 10, lines 1-14; and as best seen in FIGS.1-5.

With respect to claims 14-18 Haines et al disclose all the limitations, as set forth in column 8, lines 54-67, column 9, lines 1-67, column 10, lines 1-14; and as best seen in FIGS.1-5.

With respect to claims 1-12, 19-37, the method steps, as set forth, would have been inherently carried out in the operation of the device, as set forth above.

With regard to the recitation that an element is "configured for", it is noted that it has been held that the recitation that an element is "configured for" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense.

***Response to Amendment***

Applicant's arguments, see Remarks, filed 4/30/07, with respect to the rejection(s) of claim(s) 1-30 under 102 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Haines/Coates et al.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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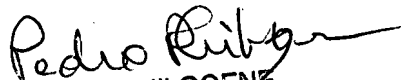
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Pedro Philogene  
June 28, 2007

  
PEDRO PHILOGENE  
PRIMARY EXAMINER